

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated March 1, 2004, indicated that claims 1-11 stand rejected under 35 U.S.C. § 101 over claims 1-11 of prior U.S. Patent No. 6,301,607 B1. Claim 18 stands rejected under the judicially created doctrine of obviousness-type double patenting over the claims of U.S. Patent No. 6,301,607 B1. Claims 12-17 stand rejected under 35 U.S.C. § 103(a) over *Mayle et al.*, (U.S. Patent No. 6,018,774) in view of *Anupam et al.*, (U.S. Patent No. 5,862,330).

Applicant submits that the Section 101 rejection of claims 1-11 has been overcome with the claim amendments.

Applicant submits the attached Terminal Disclaimer removes any rationale for maintaining the rejection of claim 18 under the judicially created doctrine of obviousness-type double patenting. Applicant therefore requests that the rejection of claim 18 be removed.

Applicant respectfully traverses the Section 103(a) rejection of claims 12-17 because the rejection fails to set forth a *prima facie* case of obviousness. As indicated in the M.P.E.P., establishing a *prima facie* case of obviousness requires that the combination of references teach or suggest all of the claimed limitations, and further that there be motivation to combine the references. In this instance, the combination of the '330 reference with the '774 reference fails to teach all of the claimed limitations. Furthermore, the Office Action does not provide evidence of motivation for making the asserted modifications in the manner required in the M.P.E.P.

The primary '774 reference fails to teach claimed limitations including those directed towards "displaying and sharing digital images using an internet access appliance with telephony and image capture capability" as asserted in the Office Action. Specifically referring to page 3 of the Office Action, the assertion that the '774 reference teaches "displaying and sharing digital images using an internet access appliance with image capture capability" is unsupported and contrary to the teachings of the '774 reference. The rejection failed to show any portion of the '774 reference that suggests that the described system has image capture capability. In addition, Applicant has briefly reviewed the '774

reference and cannot ascertain any such teaching or suggestion. Furthermore, it appears that the system and approach of the '774 reference has an object, or goal, that involves processing images captured by another device, such as with a digital photography device or a conventional camera (wherein the image is converted into a digital image). *See, e.g.*, column 2, lines 32-44 and column 3, lines 5-10. In this regard, the '774 reference not only fails to mention an internet access appliance capable of both telephony and image capture functions, it further teaches away from using an internet appliance that captures images and communicates via telephony communications. The Section 103 rejection therefore fails to meet the above-discussed criteria for establishing a *prima facie* Section 103 rejection of claim 12 (requiring that there be teaching or suggestion for all claimed limitations).

In view of the failure of the cited combination of reference to teach or suggest all of the limitations of claim 12, Applicant submits that the Section 103 rejection of claims 13-17, which depend from claim 12, are also improper for similar reasons.

The motivation asserted in support of combining the secondary '330 reference with the primary '774 reference is unsubstantiated by any cited evidence from the prior art. For example, the motivation alleged on page 4 of the Office Action is generally conclusive in nature and fails to cite any supporting evidence. Specifically, it is unclear how one of skill in the art would have been motivated to replace the computer of the '774 reference with a telephony appliance for establishing a telephony conversation. While the Office Action has asserted on page 4 that such motivation "would have been to provide users with the option of building a more interactive communication session while sharing information," no evidence showing that such interaction would have been motivated has been cited. Rather, it appears that the Applicant's invention has been used, in hindsight, to piece together the cited references. Such hindsight speculation, without any supporting evidence, is improper and fails to meet the motivation requirement of a *prima facie* Section 103 rejection. Moreover, as discussed above, modifying the '774 reference to replace the computer, which is adapted to receive digital information from another appliance, with an appliance that captures the digital image itself would undermine the purpose of the '774 reference. Relevant case law indicates that, where the purpose of a reference would be undermined by its modification, there is no motivation to make the modification.

In addition to the above-described motivation-related deficiencies, the Office Action further failed to cite or even assert any motivation for combining elements of the secondary

'330 reference with the primary '774 reference in connection with the rejection of claims 13-17. In this regard, the Section 103 rejection of dependent claims 13-17 further fails to meet the motivation requirement for establishing a *prima facie* case of obviousness.

In view of the above, Applicant submits that the Section 103 rejection of claims 12-17 is improper and should be removed.

New claims 19-28 are believed allowable for reasons including those discussed above in connection with the rejections of claims 1-18. For example, the references cited in connection with the Section 103 rejection as discussed above fail to teach limitations directed towards capturing and sending images with an internet appliance having image capture ability.


Authorization is hereby provided for charging Deposit Account number 50-0996 (8X8S.125C1) in the amount of \$316 for new claims 19 - 28, including 2 independent claims, and to charge/credit the same if necessary for any deficiencies/overages.

In view of the above discussion, Applicant believes that the rejection has been overcome and the application is in condition for allowance. A favorable response is requested. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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